

REMARKS

This paper is responsive to the non-Final Office Action of October 8, 2008. Reconsideration and allowance of claims 1, 2, 6, and 9-23 are requested.

The Office Action

Claims 1, 2, 6 and 13-17 stand allowed.

Claims 7, 11, and 18 stand rejected under 35 U.S.C. § 103 over Byers (US 4,969,468) in view of Booker (US 2003/0114906).

It appears that claims 8-10 and 20 may stand rejected under 35 U.S.C. § 103 over Byers in view of Booker, but no statutory basis for rejection is provided.

Claim 12 stands rejected under 35 U.S.C. § 103 over Byers in view of Booker, further in view of Ingman (US 2002/0082668).

Claim 19 stands rejected under 35 U.S.C. § 103 over Byers in view of Booker, further in view of Granek (US 4,729,377).

The Claims Are Now in Condition For Allowance

The Examiner's allowance of **claims 1, 2, 6, and 13-17** is noted with appreciation.

Claim 7 has been cancelled and replaced with new claim 23.

New **claim 23** is based on lines 8-11 of allowed claim 1, and the Examiner's statement of reasons for the indication of allowable subject matter. Accordingly, it is submitted that **claim 23** is now in condition for allowance.

Regarding **claim 18**, neither Byers, nor Booker, nor the combination thereof disclose or fairly suggest the combination of a layer of electrically conductive elastic material and a plurality of prefabricated conductive particles placed into and projecting from a face of the layer of electrically conductive elastic material. In Figure 4 and column 6, lines 38-53 of Byers referenced by the Examiner, a nerve electrode is constructed using semiconductor construction techniques including depositing a metallic layer 9 on a silicon dioxide substrate 8. A spacing layer 10 is temporarily covered by a mask layer 11. Protuberances 12 are grown on the metal layer 9 until the protuberances grow to be higher than the spacing layer 10 (Fig. 6).

The mask layer 11 is then removed. In this manner, when the electrode is pressed into a nerve bundle, the needle-like protuberances penetrate various layers that surround the nerve tissue and contact the nerves themselves (Byers, column 1, lines 25-38). Thus, the conductive layer 9 and the protuberances 12 become an integral metal structure formed in two vapor deposition or similar semiconductor techniques. Thus, Byers does not disclose either a layer of electrically conductive elastic material or prefabricated conductive particles pressed into a layer of electrically conductive elastic material.

Booker fails to cure these shortcomings of Byers. Booker discloses a bipolar electrode system for applying electrodes, by minimally invasive surgery, to the heart. The system includes two electrode elements, 22 and 23, which are electrically isolated from each other. The two electrodes 22, 23 are simultaneously energized from opposite poles of an electrical power supply controller 14 (Booker, paragraph [0053]). The dome electrode 23 and the planar electrode 22 are two electrically isolated electrode segments. The dome electrode 23 is not pressed into and does not project from the planar electrode 22 (Booker, paragraph [0050]). Not only is the dome electrode 23 a soft matrix or mesh, so too is the planar electrode (Booker, paragraph [0055]). Thus, Booker, like Byers, fails to disclose a plurality of prefabricated conductive particles pressed into and projecting from a face of a layer of electrically conductive elastic material.

Claims 9, 10 and 21, all dependent from claim 18, set forth additional details of the electrically conductive elastic layer, and the conductive particles. The Examiner effectively concedes that the limitations of these claims are not met by Byers and Booker, but asserts that they would be obvious on common knowledge.

Pursuant to MPEP 2144.03, the Applicant hereby challenges the Examiner's assertion of common knowledge in the art and puts the Examiner to his proofs to cite appropriate references, compatible with Byers and Booker.

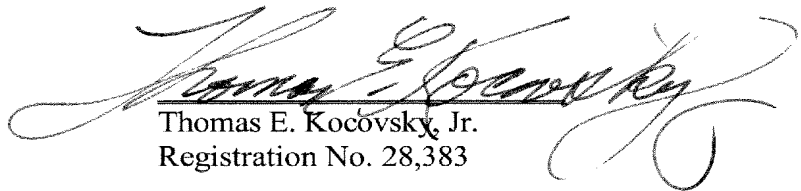
New claims 21 and 22 each add further additional details not shown by Byers and Booker.

Accordingly, it is submitted that **claim 18 and claims 9-12 and 19-22 dependent therefrom** distinguish patentably and unobviously over the references of record.

CONCLUSION

For the reasons set forth above, it is submitted that claims 1, 2, 6, and 9-23 distinguish patentably and unobviously over the references of record. An early allowance of all claims is requested.

Respectfully submitted,



Thomas E. Kocovsky, Jr.
Registration No. 28,383

FAY SHARPE LLP
The Halle Building, 5th Floor
1228 Euclid Avenue
Cleveland, OH 44115-1843
Telephone: 216.363.9000 (main)
Telephone: 216.363.9122 (direct)
Facsimile: 216.363.9001
E-Mail: tkocovsky@faysharpe.com

Direct All Correspondence to:
Yan Glickberg, Reg. No. 51,742
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
(440) 483-3455 (tel)
(440) 483-2452 (fax)